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09/401,939	09/23/1999	MICHAEL C. SCOGGIE	CAT/29US-SCROCO	5333

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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 09/401,939
Filing Date: September 23, 1999
Appellants: SCOGGIE ET AL.

Richard A. Neifeld, Ph. D
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 14, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. It is noted that U.S. patent applications 09/716,404 and 90/005,888 are not under appeal and it is not clear how those application are interference related. It is requested that the filing date of the related appeals and interferences be submitted as specified under rule 192(c)2.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: the anticipatory and double patenting rejections have been simplified to a single reference with respect to each rejection.

(7) *Grouping of Claims*

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The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because it is considered that appellants have not explained why claims of the groups are believed to be separately patentable.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5857175	Day	1/1999
5970469	Scroggie	10/1999

US Patent Application 09/567274 filed 5/2000

(10) *Grounds of Rejection*

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claims 32-70 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention and in the alternative, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The independently claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data are not enabled by the

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specification nor is it considered that the inventors had possession of the claimed invention at the time of filing, because the specification does not discuss transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data. Since the specification does not discuss these critical independently claimed elements in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claimed features are not enabled by the specification because examiner considers them to be concepts that cannot be practically applied to any embodiment of the invention such that those skilled in the art could make or use the invention. The specification merely recites vague language used in the claims and does not teach elements that one skilled in the art would need to make or use the invention. Since claims 33-44, 46-57, and 59-70 depend upon claim 32, 45, and 58 which recite the independently claimed non-enabling feature, those claims are also rejected as being non-enabling from the independent parent claim. In order to consider those claims in light of the prior art, examiner will assume that those claims contain enabling subject matter.

Claims 32-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because the

each claim reciting that feature does not provide an antecedent basis of transmitting selected data or generating token data. Since the specification does not provide an antecedent basis for these critical independently claimed steps, the independently claimed invention is not described in the claims, and as such, it fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since claims 33-44, 46-57, and 59-70 depend upon claim 32, 45, and 58 which recite the independently claimed indefinite feature, those claims are also rejected as being indefinite from the independent parent claim. In order to consider those claims in light of the prior art, examiner will assume that those claims contain non-indefinite subject matter.

Claim Rejections - 35 USC § 102

Claims 32-70 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Day et al. (US 5,857,175).

Claim Rejections - 35 USC § 103

Claims 32-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike. Since at least 1994, PerformanceBike has performed the claimed method, system, and program of:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items. Examiner also has personal knowledge of instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification. The claimed promotion data transmission and product discount display occur when the examiner went into a PerformanceBike retail outlet store and viewed discounted products from a sales catalog. The selection data transmission occurs when the examiner uses the red courtesy phone (functionally equivalent to a claimed personal computer) and calls the retail outlet distribution center (functionally equivalent to the claimed main computer). The generating, transmitting, and identifying token data occurs when examiner's frequent buyer card bar code number is processed for the product selection data made from the red courtesy phone (examiner's frequent buyer card bar code number is the same as the claimed token data). The step of determining discount items being purchased occurs when the retail

outlet distribution center verifies the final purchase order of the examiner. Generating purchase incentive based on discount items occurs when the examiner is credited with frequent buyer points rewarded for discount item purchased. The dependently claimed steps including instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification are also services and features available using PerformanceBike based on examiner's experience. The claimed invention, recited by the applicant, has been provided by PerformanceBike long before the filing of applicants' invention. Examiner takes Official notice that it is old and well known to those skilled in the art of distributing purchase incentives to consumers, that it would have been obvious to claim the invention as recited by the applicant by substituting terms with patentably equivalent claim language, in order to overcome the explicit teachings of the examiner's experienced prior art. Furthermore examiner experience teaches the claimed invention except for the personal computer display. It would have been obvious to one skilled in the art to provide a personal computer display since the computer display is merely an automated feature of a concept that is old and well known as discussed above. It is considered that the claim recitations using "computer" are an attempt to automate an old and well known process provided by PerformanceBike. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art). The motivation to combine applicants claimed invention with the services offered by PerformanceBike in order is to allow advertisers greater consumer targeting capabilities,

while transferring information, which clearly shows the obviousness of the claimed invention.

Double Patenting

Claims 32-70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,970,469. Although the conflicting claims are not identical, they are not patentably distinct from one another because the patented feature of encoded data is an obvious variation of the application claimed token and because both perform the same function in the same manner with the same result.

Claims 32-70 are rejected under 35 U.S.C. 103(a) as being obvious over copending US Patent Application 09/567,274. That application contains claims reciting obvious variation to the claimed method, system, and program of:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items along with instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in

accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

(11) Response to Argument

35 USC 112, first and second paragraphs

The specification argued by the appellants is considered a much narrower interpretation than the rejected non-enabling claimed features. The claims under rejection are considered much broader and non-enabling, such that one skilled in the art would not be able to make and use the claimed invention. Those rejected claims are considered non-enabling because the rejected claim is not recited in full, clear, concise, and exact terms as in the specification. The rejected "transmitting selection data" relates to "designating at least one product discount" along with "personal computer to main computer" network communications are not recited in full, clear, concise, and exact terms as recited in the specification. One skilled in the art would not be able to make and use the claimed invention because selection data transmission, product designation, and computer network communications is not clearly discussed in exact terms from the specification. Likewise, the rejected token data dependence upon selection data is not claimed in concise and exact terms as argued from the

specification with respect to generating a token instead of a coupon and therefore the rejected claims in light of the argued specification, are not considered enabling to one skilled in the art. In response to appellants' submission to examiner's incorrect assertion, the misquoted assertion is not an issue on appeal. The assertion is properly quoted in the final Office action and therefore moot. Finally, the argument with respect to the second paragraph rejection above has been editorially modified to more properly identify the claim language with respect to the statute.

135 USC 102

It is considered that the Day reference clearly anticipates the claimed invention because each of the claimed elements is disclosed on the face of that reference. However in order to address appellants arguments, the claimed invention will be discussed in light of Day. Day discloses the claimed method, system, and program of:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network (please see column 1 line 64 through column 2 line 5 in which the disclosed terminal is considered patentably equivalent to the claimed personal computer and the disclosed link access is considered patentably equivalent to the claimed main computer and associated network while the claimed product discounts are considered equivalent to the disclosed coupons);

displaying said plurality of product discounts at said personal computer based on said promotion data (please see column 2 lines 1-2 in which the claimed product

discount display is considered patentably equivalent to the disclosed consumer presented coupon list);

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network (please see column 2 line 3 in which the claimed product discount selection transmission is considered patentably equivalent to the disclosed discounts selected by the consumer via the earlier discussed access link);

generating token data depending on said selection data (please see column 2 lines 3-4 in which the claimed token data generation with selection data dependence is considered an implicit patentable equivalent to the disclosed discounts subtracted from a consumer's total bill wherein the claimed token data functionality is met by the disclosed discount subtraction);

transmitting said token data from said main computer to said personal computer over said computer network (please see column 2 lines 2-3 in which the claimed token data computer transmission is considered an implicit patentable equivalent to the disclosed link to check-out stations);

identifying said token data in a retail store in association with items being purchased at said retail store (please see column 2 lines 3-4 in which the claimed retail store token data identification and purchase item association is considered an implicit patentable equivalent to the disclosed discounts subtracted from a consumer's total bill wherein the claimed token data functionality is met by the disclosed discount subtraction

while column 3 line 20 discloses stores, shops, or retail outlets anticipating the claimed retail store);

determining discount items being purchased corresponding to said at least one product discount from said identified token data (please see column 2 lines 3-4 in which the claimed item purchase discount correspondence and token data identification is considered an implicit patentable equivalent to the disclosed discounts subtracted from a consumer's total bill wherein the claimed token data functionality is met by the disclosed discount subtraction); and

generating a purchase incentive based on said discount items including devices or a computer program performing those steps thereof (please see column 2 lines 3-4 in which the claimed purchase incentive basis is considered an implicit patentable equivalent to the disclosed discounts subtracted from a consumer's total bill wherein the claimed incentive basis is also considered disclosed by the captured data regarding consumer purchases in line 5). The additional dependent claimed limitations are also anticipated by Day as follows: instant or subsequent redeemable vouchers (please see column 6 lines 13-49 and column 8 lines 24-29 respectively), separate shopping lists based on selected product discounts (please see column 8 lines 9-23), main to personal computer shopping list transmission (please see column 5 lines 56-67), specific manufacturer or specific retailer discounts including pluralities thereof (please see column 4 lines 10-24), demographic data or token use or product use frequency basis (please see column 4 lines 25-41), and internet/intranet token scanning identification (please see column 3 lines 23-38 wherein the disclosed UNIX machines and the

disclosed TCP/IP communication implies the claimed intranet and internet data identification and communications). Hopefully the discussion of Day above fully shows the anticipation consideration of the claimed invention as interpreted by the Office.

35 USC 103

In order to more clearly discuss the obviousness rejection, PerformanceBike.com was used in the rejection to allow the appellants to refer to examiner's experience. A review of PerformanceBike.com would show that the company existed since the early 1980's of which examiner experience begins in 1994. Examiner's rejection is not intended to be interpreted such that online shopping from PerformanceBike.com existed in 1994, as extensively argued by appellants, but rather the claimed invention was in use by PerformanceBike under examiner's experience. The rejection above has been modified to clarify interpretation of the obviousness rejection and hopefully fully answer appellants' arguments. Answering appellants argument that a red courtesy phone does not describe or suggest displaying or main or personal computer, the rejection made above discusses that the claimed displaying occurs when the examiner went into a PerformanceBike retail outlet store and viewed discounted products from a sales catalog. The claimed personal and main computers are the obviousness automated variation, which are rejected. The interpretation equating a courtesy red phone with computers is merely to show functionality and not equivalence. Hopefully this answer clarifies appellants' interpretation. With respect to appellants' inconsistent and irrelevant arguments, the rejection again was not made to show equivalence but rather

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obviousness. Examiner addresses specific time, place, and event in the rejection based on a purchase made at a PerformanceBike retail outlet since at least 1994 as discussed in the final Office action repeated above.

Obviousness-type double patenting

To answer appellants' response that the patented purchase incentives associated with recipes is not an obvious variation from the presently claimed purchase incentives associated with token data, both recipes and token data are considered information or data which is non-functional descriptive material. Both the claimed pending invention and claimed patented invention perform the substantially the same process, with substantially the same result, in substantially the same way. It would have been obvious to apply the earlier patented recipe purchase incentive for token data purchase incentive, since recipe and token data are considered merely non-functional descriptive material.

Provisional obviousness-type double patenting

To answer appellants' response that a copending application does not qualify as prior art, a prior art rejection was not made with appellants' commonly owned application but rather a rejection was made to prevent an unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
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Primary Examiner
Art Unit 3622

smg
August 14, 2003

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